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Gabriel Lopez		JULY 15, 2004
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DOCKET NO. ORT-1451

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Alexey B. Dyatkin et al.

Serial No.: 09/891,602                      Art Unit: 1625  
Filed : June 26, 2001                      Examiner: Aulakh, Charanjit  
For : AZA-BRIDGED BICYCLIC AMINO ACID DERIVATIVES

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY AND AMENDMENT

Sir:

This is in reply to an Office Action dated March 16, 2004.

Cancel the present claims and add claims 59-107. The claims appear on pages 4-21. The original and re-drafted claims are related as follows:

Original	Present
1-19	59-77
21-24	78-81
28-36	82-90
57	91
25-27	92-94
44-46	95-97
48-56	98-106
58	107

Claims 1-19, 21-36, 44-46, and 48-58 are rejected under 35 USC 112 as non-enabling when certain combinations of substituents

form monocyclic rings. The rejection is traversed. However, the claims as re-drafted do not recite these types of rings.

Claims 1-19, 21-23, 25, 26, 32-36, 44-46, and 48-58 are also rejected under 35 USC 112 as indefinite because they include certain terms. The rejection is traversed.

"Heteroaryl" and "heterocyclyl" are said to be not defined in the claims. Unless there is some specific reason to do so, such terms are typically not defined in US patent claims since doing so merely adds unnecessary verbiage. The meanings of these terms are clear from the specification (see pages 37 and 38). Similar terms in the claims, which the Examiner has not commented on, include: alkyl, halogen, alkoxy, aryl, etc. If the Examiner persist in this rejection, it is requested that he provide a justification under 35 USC 112 for rejecting "heteroaryl" and "heterocyclyl" but not "aryl" and the other similar terms.

"Comprise" has been deleted from the new claims.

The expression "optionally present" is not indefinite under 35 USC 112. The rejection is deemed to be based on the Examiner's stylistic preference and not on the statute. The PTO website lists 57,565 US patents issued since 1976 with this expression in the claims. One or two inclusions of the expression might be understood to be inadvertent error by the Office. However, 57,565 inclusions indicate that the expression is proper.

The expression "integrin mediated disorder" is said to be indefinite. The Examiner states that the specification does not teach any disorder which is mediated by integrin. The Examiner's attention is directed to pages 1, 21, and 40 and to claims 41-43 and 51-53. Further, applicants are not limited to the text of a specification but can, and as a practical matter must, rely on the state of the art. Otherwise every patent specification would be more than encyclopedic in size. The relationship between integrin and disorders has been well-described in the literature. The Examiner's attention is directed to pages 1-14 of the specification with regard to this art. Further, data have been presented to show that the compounds are antagonists of integrin receptors, as a


consequence of which the compounds are useful in the treatment of integrin mediated disorders.

It is requested that the amendment be entered and that the Examiner reconsider the rejection in view of the amendment and remarks and that the case be passed to issue.

It is requested that the period for response be extended two months to July 16, 2004.

The Commissioner is hereby authorized to charge any fees which may be required by this paper to Deposit Account 10-0750/ORT-1451/GL

Respectfully submitted,

  
Gabriel Lopez  
Attorney for Applicants  
Reg. No. 28,440  
(732) 524-1495

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003

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